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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

016295.1518

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Application Number

10/758,889

Filed

January 16, 2004

First Named Inventor

Pratik M. Mehta et al.

Art Unit

2439

Examiner

Wang, Harris C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 60,135
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Brian K. Prewitt

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512.322.2684

Telephone number

Mar. 2, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Pratik M. Mehta et al.
Serial No.: 10/758,889
Date Filed: January 16, 2004
Group Art Unit: 2439
Confirmation No.: 6993
Examiner: Wang, Harris C.
Title: **METHOD TO DEPLOY WIRELESS
NETWORK SECURITY WITH A
WIRELESS ROUTER**

MAIL STOP – APPEAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL REQUEST AND ARGUMENTS

The following Pre-Appeal Brief Request for Review (“Request”) is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 (“OG Notice”). At the time of the Final Office Action mailed December 10, 2008, Claims 1, 4-10 and 21-32 were pending in this Application. Claims 1, 4-10 and 21-32 were rejected. No claim amendments are hereby requested. Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

ARGUMENTS

Applicant contends that the rejections of Claims 1, 4-10 and 21-32 on prior art grounds and as non-statutory contain clear legal and factual deficiencies, as described below. Claims 1, 21-23, 25 and 30 stand rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0178365 by Shingo Yamaguchi ("*Yamaguchi*"). Claims 4-5 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yamaguchi* in view of U.S. Patent Application Publication No. 2003/0154287 by Gary E. Sullivan ("*Sullivan*"). Claim 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yamaguchi* in view of U.S. Patent Application Publication No. 2003/0200455 by Chi-kai Wu ("*Wu*"). Claims 6-10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Yamaguchi* in view of U.S. Patent Application Publication No. 2003/0078072 by Zeljko John Serceki et al. ("*Serceki*") further in view of Windows Millennium Edition 2000 ("*Windows*").

Applicant contends that the rejections of Claims 1, 4-10 and 21-32 are not proper for the reasons described in Applicant's Response dated January 26, 2009 at Pages 8-10 ("Applicant's Response"). In short, Applicants contend that, contrary to the Examiner's assertions, the cited references do not teach, either alone or in combination, each and every element of the recited claims.¹

For example, as noted in Applicants' Response, Claim 1 recites the following elements:

- "in a wireless network ***having a deactivated wireless network security*** for the wireless network such that at least a first wireless client and a second wireless client ***can access the wireless network without authentication***, a wireless host establishing a communication connection with the first client;"
 - "in association with the determination to activate the wireless security network, the wireless host receiving an identifier code from the first client;"
- and

¹ It is noted in the OG Notice at <http://www.uspto.gov/web/offices/com/sol/og/2005/week28/patbref.htm> that "Applicants are encouraged to refer to arguments already of record rather than repeating them in the request." Accordingly, Applicants refer here to, and summarize, the previous arguments rather than reciting them explicitly.

- “the wireless host determining that the received identifier code from the first client matches a unique key-code maintained by the wireless host.”

In the Final Office Action, the Examiner states that these last two elements are taught by *Yamaguchi* at Paragraph [0005] which states in part: “In order to use such WEP encryption, the user sets the same encryption key in both the end client or the laptop computer, and also the access point which communicates with the wireless device.” (Final Office Action, Page 3-4). The Examiner states that “The Examiner interprets the ‘received identifier code’ as the encryption key used to set up WEP.” (Final Office Action, Page 3). However, as noted by Applicants in Applicants’ Response, if the WEP encryption key is communicated from the first client to the wireless host, this would necessarily mean that WEP would already be set up prior to the communication of such encryption key. If WEP is already set up, then the network is not a “wireless network having a deactivated wireless network security” wherein “at least a first wireless client and a second wireless client can access the wireless network without authentication.” To the contrary, if WEP is set up, then the wireless network is one having activated wireless network security and, by using the already-set WEP key, the wireless client is accessing the network with authentication.

The Examiner responds to this argument in the Advisory Action as follows:

Examiner disagrees that having “an already set up WEP key” precludes *Yamaguchi* from anticipating the limitation “having a deactivated wireless network security” It appears the Applicant is equating the term “deactivated network security” with a network that has never set up any network security. Dictionary.com defines the term “deactivate” as “to cause to be inactive; remove the effectiveness of.” The Examiner submits that whenever the [sic] any network security has ever been set up is not claimed in the claim limitations, only that the wireless network currently has a “deactivated wireless network security.” According to the plain meaning of the term “deactivated” the Examiner believes *Yamaguchi* anticipates “having a deactivated wireless network security.”

(Advisory Action, Continuation Sheet).

This assertion by the Examiner fails, because, among other things, the Examiner fails to consider that “to cause to be inactive” can include not making something active in the first place, and thus “deactivated” includes the case in which WEP has never been set up. In addition, regardless of what a specific dictionary may set forth regarding the definition of “deactivated,” “deactivated” must clearly mean the opposite of “activated.” As discussed

above, *Yamaguchi* describes a system in which WEP has already been set up, necessarily meaning that wireless network security is “activated.” Thus, given that common sense dictates that “activated” is the opposite of “deactivated,” *Yamaguchi* cannot be said to anticipate “having a deactivated wireless network security.”

Nonetheless, even if we do accept the Examiner’s strained construction that “deactivated” can somehow include “activated,” the Examiner has ignored arguments in Applicants’ Response that establish that *Yamaguchi* fails to disclose, either expressly or inherently, “such that a first wireless client and a second wireless client *can access the wireless network without authentication*, a wireless host establishing a communication connection with the first client,” as recited in Claim 1. As shown in the Borisov et al. reference (“*Borisov*”) previously submitted in an IDS by the Applicants, WEP is not only an encryption standard but also a communication standard employing authenticated messages. (See, e.g., *Borisov*, pp. 5-8). Thus, if *Yamaguchi* indeed shows two different wireless cards, one with WEP encryption enabled and one without, only the one employing WEP encryption can access the network, but it cannot do so without WEP authentication, and the one not employing WEP encryption cannot access the network at all. Accordingly, this necessarily means that *Yamaguchi* does not disclose “at least a first wireless client and a second wireless client [that] can access the wireless network without authentication” as recited in Claim 1.

For at least these reasons, *Yamaguchi* does not teach each and every element of Claim 1, and thus cannot anticipate Claim 1. For the same or analogous reasons, *Yamaguchi* fails to anticipate Claims 25 and 30 which include limitations similar to those set forth in Claim 1. Given that Claims 21-23 depend from Claim 1, Applicants submit that Claims 21-23 are also allowable. Although the Applicants make no concessions regarding the rejections of Claims 4-10, 24, 26-29 and 31-32, Applicants submit that: (i) Claims 4-10 and 24 are allowable at least because they depend from and provide further limitations to Claim 1, shown to be allowable above; (ii) Claims 26-29 are allowable at least because they depend from and provide further limitations to Claim 25, shown to be allowable above; and (iii) Claims 31-32 are allowable at least because they depend from and provide further patentable limitations to Claim 30, shown to be allowable above. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a), and full allowance of Claims 1, 4-10 and 21-32.


CONCLUSION

Applicant submits these Arguments in Support of Pre-Appeal Brief Request for Review along with a Notice of Appeal. Applicant authorizes the Commissioner to charge Deposit Account No. 50-2148 in the amount of \$540.00 for the Notice of Appeal.

Applicant believes there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayments to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2684.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicant



Brian K. Prewitt
Reg. No. 60,135

Date: Mar. 2, 2005

SEND CORRESPONDENCE TO:

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